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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/909, SLA 1/27/1987 GERRARD JR. W 0155-11007-5

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EXAMINER

CUNNINGHAM, J.

ART UNIT

PAPER NUMBER

1648

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DATE MAILED:

04/23/89

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/989,896**

Applicant(s)  
**Gehrmann et al.**

Examiner  
**Thomas Cunningham**

Group Art Unit  
**1644**



Responsive to communication(s) filed on \_\_\_\_\_

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

X Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

X Claims 1-26 are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1644

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 23-26, drawn to polypeptide compounds, classified in class 530, subclass 350 or 395.
- II. Claims 14-22, drawn to nucleic acids, vectors, host cells and methods of recombinantly producing a protein, classified in class 536, subclass 23.5, Class 435, subclasses 69.1, 252.3 and 320.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to structurally and functionally distinct products: polypeptides or nucleic acids.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Upon election of Group I, claims 1-13 and 23-26 are generic to a plurality of disclosed patentably distinct species comprising polypeptides comprising materially different antigen binding regions, amino acid sequences, and/or chemical structures. Applicant is required under 35 U.S.C. 121 to elect a single ultimately disclosed species, even though this requirement is traversed. An example of an electable species would be the sFv-hu $\beta$ -Gluc fusion protein

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described on page 5 of the specification. The Applicant is required to specify all relevant structural and functional characteristics of the elected species.

Upon election of Group II, claims 14-22 Applicant is required to elect one ultimately disclosed species of nucleic acid sequence. An example of an electable species would be the nucleic acid sequence consisting of the sequence described by claim 16.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Sequence Letter

7. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

**The specification and claims describe numerous amino acid and nucleic acid sequences that are not identified by SEQ ID NO. See e.g. claim 16 and inter alia pages 25-29 and 33 of the specification.**

Any inquiry concerning this communication from the examiner should be directed to THOMAS CUNNINGHAM, whose telephone number is (703) 308-3968. Inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0196.

THOMAS CUNNINGHAM PH.D, J.D.

TC  
THOMAS CUNNINGHAM  
PRIMARY EXAMINER  
GROUP 1800

Art Unit: 1644

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT  
APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE  
AND/OR AMINO ACID SEQUENCE DISCLOSURES

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with one or more of the requirements of 37 CFR 1.821-1.825 as follows:

**Applicant must provide:**

1. An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
2. An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
3. A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

**Customer service:**

For questions regarding compliance with these requirements, please contact:

For Rules Interpretation, call (703) 308-1123.

For CRF submission help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856.

--PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE--